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| APPLICATION NO.  | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|---------------|----------------------|---------------------|------------------|
| 10/821,959   | 04/12/2004    | Bernhard Geuppert    | 861840-999025       | 2358             |
| 51442  | 7590          | 08/22/2008           | EXAMINER            |                  |
| JONES DAY<br>222 East 41st Street<br>New York, NY 10017-6702 |               |                      | KIM, PAUL D         |                  |
| ART UNIT   | PAPER NUMBER  |                      |                     |                  |
|  | 3729          |                      |                     |                  |
| MAIL DATE  | DELIVERY MODE |                      |                     |                  |
| 08/22/2008   | PAPER         |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |
|------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/821,959 | <b>Applicant(s)</b><br>GEUPPERT ET AL. |
|                              | <b>Examiner</b><br>Paul D. Kim       | <b>Art Unit</b><br>3729                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 June 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-16,20,23,26,28-30,32-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-16,20,23,26,28-30,32-36 and 38-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No.(s)/Mail Date 0/18/08
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/18/2008 has been entered.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9-15, 20, 23, 26, 28-30, 32-36 and 38-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Oshino (EP 1338911 A2).

Oshino teaches a process of making an optical component comprising steps of: mounting a substrate (20, as shown in Fig. 2(a) or 54, as shown in Fig. 3) on a mounting frame (25, as shown in Fig. 2(a) or as shown in Fig. 3 ) including a support

member (as shown in Fig. 2(a) or 52 as shown in Fig. 3) and plural attachment members (as shown in Fig. 2(a) or 58, 58', 59, 59' as shown in Fig. 3) being connected to the support member at plural locations on the support member and separated from one another, the substrate being mounted to the mounting frame via the plural attachment members (as per claim 35) as shown in Figs. 2(a) and 2(b) or as shown in Fig. 3; measuring a shape of the optical surface of the substrate; and physically processing (such as polishing as per claim 15) the optical surface as disclosed in col. 15, the paragraph [0055], wherein the substrate is mounted on the mounting frame including the support member during the measuring and the processing the optical surface (see also paragraph [0032] to paragraph [0039] and paragraph [00472] to paragraph [0055]). Oshino also shows the optical system as shown in Fig. 1 (also see paragraph [0032] to [0034], as per claims 20 and 23).

As per claim 10 the substrate is permanently mounted on the mounting frame during the measuring and the processing the optical surface.

As per claims 11, 23 and 29 the mounting frame comprises more than three contact portions (22) or plural attachment members disposed at distances from each other as shown in Fig. 2(a) for providing a mounting contact.

As per claim 12 the mounting frame is mounted to at least one adjacent mounting frame (40) as shown in Fig. 5.

As per claim 13 Oshino also teaches that the error (equivalent with a difference) is removed while the substrate is mounted on the frame (see paragraph [0048]).

As per claim 14 the measuring of the shape of the substrate is performed while the substrate is disposed in an orientation with respect to a direction of gravity (such as downward), which is substantially the same as the predetermined orientation as shown in Fig. 2(b).

As per claims 26, 30, 36, 40 and 42 the mounting frame is capable of supporting the substrate in an optical system.

As per claims 28, 32 and 38 the support member is a ring shaped member as shown in Fig. 2(a).

As per claims 29, 33 and 39 the support member comprises a continuous member supports the plural attachment members as shown in Fig. 2(a).

As per claim 41 a contact between the substrate and the mounting frame extends over a substantially continuous peripheral region near a periphery of the substrate as shown in Figs. 2(a) and 2(b).

***Claim Rejections - 35 USC § 103***

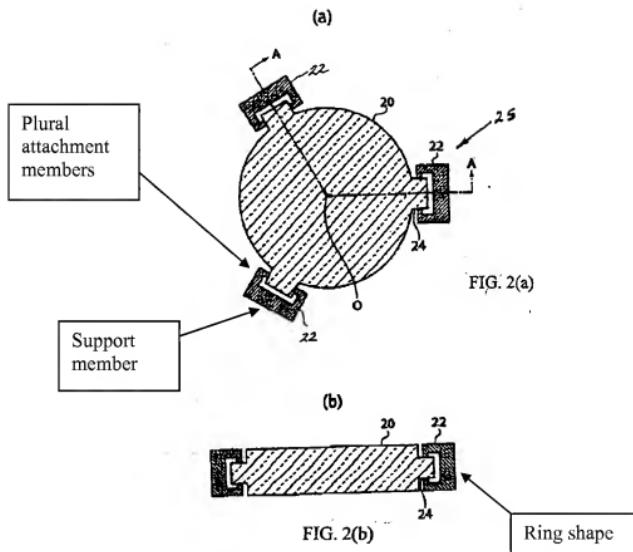
3. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Oshino in view of Malyak et al. (US PAT. 6,515,750).

Oshino teaches all of the limitations, but fail to disclose how the measuring process is preformed. Malyak et al. teach an interferometric system for an optical component in order to allow measuring semi-transparent optical objects (see also col. 6, lines 36-41). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a process of measuring the surface

of the optical component of Oshino by using an interferometric system as taught by

Malyak et al. in order to allow measuring semi-transparent optical objects.

EP 1 338 911 A2



EP 1 338 911 A2

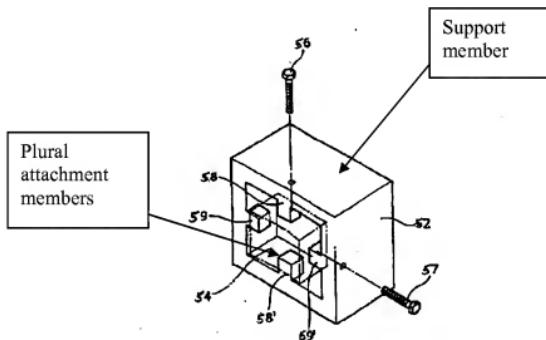


FIG. 3

***Response to Arguments***

4. Applicant's arguments with respect to claims 9-16, 20, 23, 26, 28-30, 32-36 and 38-42 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's arguments filed 6/18/2007 have been fully considered but they are not persuasive. Applicant argues that the mounting frame of Oshino fails to teach the mounting frame having a support member and plural attachment members being connected to the support member at plural locations on the support member and separated from one another, the substrate being mounted to the mounting frame via the plural attachment members. Examiner traverses the argument. The mounting frame (25, as shown in Fig. 2(a) or as shown in Fig. 3 ) of Oshino includes a support member (as shown in Fig. 2(a) or 52 as shown in Fig. 3) and plural attachment members (as shown in Fig. 2(a) or 58, 58', 59, 59' as shown in Fig. 3) being connected to the support member at plural locations on the support member and separated from one another, the substrate being mounted to the mounting frame via the plural attachment members as shown in Figs. 2(a) and 2(b) or as shown in Fig. 3.

Applicant also argues that Oshino fails to teach the substrate that is mounted on the mounting frame including the support member during the measuring and the processing the optical surface. Examiner also traverses the argument that the substrate is mounted on the mounting frame including the support member while the plural attachment members are attached thereto (dol. 15, lines 14 and 15, and as shown in Fig. 5) during the measuring and the processing the optical surface.

Applicant also argues that Oshino fails to teach the supporting member is not a ring shape. According to the Figs 2(a), 2(b) and 3, the support member is a ring shape.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Thursday between 6:00 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul D Kim/  
Primary Examiner, Art Unit 3729